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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/889,701      | 11/05/2001  | Andrew Heaton        | 07579.0014          | 8634             |

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Washington, DC 20005

EXAMINER

SHAMEEM, GOLAM M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1626

DATE MAILED: 09/23/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

09/889,701

Applicant(s)

HEATON ET AL.

Examiner

Golam M M Shameem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 10-39 and 41-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 10-39 and 41-46 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-46 are pending in the application. Claims 10-39 and 41-46 are withdrawn from consideration by the Examiner under 37 C.F.R. 1.142 (b) as directed to non-elected subject matter.

### ***Response to Election/Restriction***

Applicant's election with traverse of Group I, claims 1-9 and 40, in paper No.8 filed June 19, 2002, is acknowledged. The traversal is on the ground(s) that each of the elected Group could be extended to other Groups without imposing an undue burden on the Examiner. This argument is not persuasive because each of the Group is directed to art-recognized process/method, which is different from each other and, are capable of supporting their own patents. The wide disparity among the groups requires that many divergent fields must be searched, including all classes and subclasses of U.S. and foreign patents as well as journals and publications.

Applicants also argue that since no lack of unity was found in the international phase of the application, it is improper at the national stage. However, 35 U.S.C. 372(b)(2) clearly states that unity of invention may be reexamined under the 35 U.S.C. 121. Additionally, the 35 U.S.C. 121, statutory patent law, is the singular basis for the restriction. The 35 U.S.C. 121 makes clear that restriction may be required in certain applications and that the Director/Commissioner has the right to make such a determination. In addition, the applicant's nowhere present evidence to the contrary that they are claiming independent and distinct inventions.

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For these reasons, applicant's arguments are found unpersuasive and, since 35 U.S.C. 101 allows one patent per invention, the requirement for restriction in Paper No. 5 is still deemed proper and is therefore made FINAL.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants preserve their right to file a divisional on the non-elected subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Szabo et al (1973) and Inoue (1964). Applicant claims a process for the production of isoflavones derivatives by a hydrogenation reaction. Szabo et al (1973) and Inoue (1964) independently disclose the process of preparing isoflavones derivatives by selective catalytic reduction of isoflavone using palladium catalyst in ethanol (In Tetrahedron Letters, line 3, second paragraph, page 1659) and also using platinum oxide catalyst (STN International, CAPLUS database, page 5, document number 61:32297), which read on the instantly claimed process.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 40, is rejected under 35 USC § 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The expression "any preceding claim" renders the claim indefinite because the claim does not itself define invention but relies on external material and modern claim practice requires that the claims stand alone to define the invention. Ex parte Fressola, 27 USPQ2d 1608. It is indefinite because the above expression is not defined in the claim so as to ascertain the metes and bounds of the claimed subject matter. It is suggested to rewrite this claim as an independent form (deleting "or formula III or formula IV or formula V ") including all of the limitations of the base claim and any intervening claims or amend the above phrase with in the context and scope of the claim in order to overcome the rejection.

***Claim Objections***

Claim 40 is objected to for containing non-elected subject matters (such as formula III, or formula IV etc.). The claims must be amended to exclude non-elected subject matter and within the limit of the elected compound of formula II to satisfy the restriction requirement in order to place the case in condition for allowance. Appropriate correction is required. Claims 1-9 may be allowable.

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (703) 305-0116. The Examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

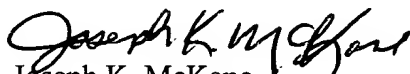
When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.

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Joseph K. McKane  
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September 19, 2002